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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,606	12/08/2003	Patrick J. Sweeney	029815-0105	4015
26371	7590	07/11/2006		
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			EXAMINER STEWART, ALVIN J	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/730,606	Applicant(s) SWEENEY, PATRICK J.	
	Examiner Alvin J. Stewart	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 26, 2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, and 25-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 25 and 41 have been rejected under 35 U.S.C. 112, 2nd paragraph because the Applicant is positively claiming two separate shafts (a shaft and a replacement shaft) and the problem that the Examiner has is that one shaft replaces the other one and it seems like the claimed joint prosthesis has two shafts at the same time.

The Examiner understands the invention. However, in order to clarify the claims, the Examiner suggests to add the following language (in the claim and the specification): for example, in claim 1, line 5, ---and a plurality of modular shafts; wherein a first shaft is coupled to the body and extends through the central canal and a second replacement shaft, wherein the

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first shaft is interchangeable after implantation of the prosthesis by removing the shaft and replacing the shaft with the second replacement shaft without dislodging the body from the patient---.

Response to Arguments

Applicant's arguments filed 04/26/06 have been fully considered but they are not persuasive.

The Examiner maintains the previous rejection because of the following reasons: as discloses above claims 1, 25 and 41 are rejected under 35 USC 112, 2 nd paragraph because they are not clear. It seems like the two shafts are positively claimed at the same time, for the above reasons, the Examiner believes that the previous rejection is proper. In claim 1, lines 6 and 7, the Applicant's representative is claiming, "the shaft is interchangeable..." and "by removing the shaft..." the Examiner can interpret the shaft as the "replacement shaft" and not "the shaft". For the above reasons, the "replacement shaft" is capable of being interchanged after implantation.

Finally, the Applicant representative can add structure limitations disclosing that the shafts extend out from the base.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-13, 15-18, 25-27, 30-33, 35-28, 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Ganjianpour 6,716,250. The invention is understood, and as amended Ganjianpour discloses the invention as currently claimed comprising: a body (element 18) having a central canal (34); extending there through; *a head coupled to the body (22)* ; a shaft (26) coupled to the body and extending through the central canal *and a replacement shaft (30* it is inherent that a screw has a head and a shaft/stem portion) wherein the shaft is *capable of being interchanged after implantation of the prosthesis by removing the shaft and replacing the shaft (30) with a replacement shaft without dislodging the body from the patient (all functional and capable of being performed by Ganjianpour)*; wherein the shaft is coupled to the body via insertion of the shaft through an end of the central canal nearest an articular surface of the prosthesis (the articular end is the surface of body/neck 19 see fig. 7 where a head can be attached); wherein the device is configured for a hip joint or shoulder joint (the device can be put into an animal of varying sizes to replace there shoulder joint); wherein the shaft is a nail; wherein the replacement shaft is longer than the shaft (see fig. 7 how it extends); wherein an insert is coupled to the body and extending at least partially into the central canal (read col. 7, lines 63-64 “groove shaft 26 inserted).

Claim Rejections - 35 USC § 103

Claims 3-4, 14, 28-29, 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganjianpour in view of Pennig 5,375,956. Ganjianpour has been disclosed above however. Ganjianpour does not specify the term Morse. Ganjianpour does however have a tapered section that is coupled to the shaft (see col. 8, line 51-55). It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to provide a Morse taper lock as claimed because the taper of Ganjianpour is tapered and the Morse taper is well known in the art (as admitted in applicants specification) and is a matter of design modification and thus not novel. Ganjianpour shaft has an unthreaded head recess. Pennig 5,375,956 as an example of modified screw with shaft and head and the tool used to removal. It is also obvious that a "remover" such as screw driver device can be used to remove the shaft from the insert. If the head of the screw has threads than a threaded tool would be used to unscrew the device see Pennig 5,375,956 as an example of modified screw with shaft and head and the tool used to removal.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,524,342 B1 Muhlhausler et al discloses a body, a head and a plurality of different shafts capable of being inserted through a central canal (see Figs. 1-5 and col. 4, lines 1-63).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Alvin Stewart whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4760.

The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-830006.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

July 03, 2006.


ALVIN J. STEWART
PRIMARY EXAMINER